

REMARKS

Status of the claims:

With the above amendments, claims 1, 11, and 17 have been amended, claims 24-25 are added, and claims 1, 3-5, 7, 9-11, 13-14, and 16-25 are pending and ready for further action on the merits. No new matter has been added by way of the above amendments. Support for the amendment to claims 1, 11, and 19 can be found at page 7, paragraph [0031], lines 8-9. Support for new claims 24 and 25 can be found at paragraph [0031]. Reconsideration is respectfully requested in light of the following remarks.

Examiner Interview

Applicants' representative would like to thank the Examiner and the Examiner's supervisor for holding a telephonic interview on May 9, 2006. No agreement was reached in the interview. The cited art was discussed.

Drawing Objections

The Examiner has objected to the drawings asserting that every feature that appears in claims 9 and 22 is not in the drawings. Applicants herein submit new drawings (i.e., Figures 9-11) with the additional features as claimed. No new matter has been added in these figures. Removal of the objections is respectfully requested.

Rejections under 35 U.S.C. § 102

Claims 1, 3-5, 7, 9-11, 13-14, and 16-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Rivin '304 (US Patent No. 5,322,304). Applicants traverse.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Applicants assert that Rivin '304 fails to disclose each and every element as set forth in the claims as currently amended.

In the Office Action of January 30, 2006, the Examiner asserts:

Rivin discloses an apparatus (see Figures 5-7) comprising: a first element 40 adapted to be coupled with a second element 48, the first element 40 comprising a structured surface 64 and the second element comprising a second surface 48, wherein the second surface 48 comprises a receiving surface 48b and wherein the structured surface 64 comprises a plurality of depressions (depressions in 64 for balls 46).

The Examiner asserts that Rivin '304 discloses a structured surface 64 that comprises a plurality of depressions. Regarding these depressions, Rivin '304, at column 10 lines 4-16 recites:

All of the embodiments can have their crevices or voids sealed or filled with a soft material 64 (see FIGS. 7 and 8, for example) such as a soft solid, or a foam elastomer. Material 64 may, as to each embodiment, be arranged to effectively fill out the voids in the conical envelope. Material 64 is preferably such as not to significantly affect the deformation characteristics of the structural resilient elements (shells, pins, collars, balls) while eliminating danger of accumulating debris around the operating elements of the tool holder with resultant modification in the tool holder performance characteristics.

From this disclosure it should be apparent to those of ordinary skill in the art that the material 64 in Rivin '304 is added to the crevices or voids in the conical envelope by sealing or filling the material into these crevices or voids in the conical envelope. Thus, the depressions are not created by machining as is instantly claimed in the present invention. Accordingly, Rivin '304 fails to disclose all of the elements of the instantly

claimed invention. Rivin '304 cannot anticipate claims 1, 3-5, 7, 9-11, 13-14, and 16-23 because Rivin '304 fails to disclose each and every element of the claimed invention. The rejection is inapposite. Withdrawal of the rejection is warranted and respectfully requested.

Rejections under 35 U.S.C. § 103

Claims 10 and 21 are rejected under 35 U.S.C. §103(a) as being unpatentable over Rivin '304 in view of Slocum '126 (US Patent No. 6,280,126). Applicants traverse.

Removal of the Rejection over Rivin '304 in view of Slocum '126 under 35 U.S.C. § 103

Applicants assert that the Examiner has failed to establish a proper *prima facie* case of obviousness regarding the rejection of claims 10 and 21 using Rivin '304 in view of Slocum '126.

To establish a proper *prima facie* case of obviousness, three basic criteria must be met.

- 1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.
- 2) There must be a reasonable expectation of success.
- 3) The prior art reference (or references when combined) must teach or suggest all the claim limitations.

See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) and MPEP 2142.

Applicants submit that the Examiner has failed to show any of these criteria. For example, the Examiner has failed to show criteria 3) that the prior art reference (or references when combined) teach or suggest all the claim limitations. Claims 10 and 21 are dependent from independent claims 1 and 17, respectively. Accordingly, if elements in the independent claims are not present, a proper *prima facie* case of obviousness has not been presented.

The deficiencies of Rivin '304 were discussed above. In particular, Rivin '304 fails to disclose a structured surface that comprises a plurality of depressions wherein the depressions are formed by machining. Slocum '126 fails to make up for the deficiencies of Rivin '304. Slocum '126 does not disclose any depressions in its damping tool holder. Accordingly, the combination of Rivin '304 and Slocum '126 cannot render the present invention *prima facie* obvious because the two references simply fail to disclose all of the elements of the instantly claimed invention. Withdrawal of the rejection is warranted and respectfully requested.

CONCLUSION

With the above amendments and remarks, Applicants believe that all objections and/or rejections have been obviated. Thus, each of the claims remaining in the application is in condition for immediate allowance. A passage of the instant invention to allowance is earnestly solicited.

Applicants respectfully petition for one month extension of time. Applicants believe that no additional fee is necessary, however, should a fee be deemed to be

necessary, the Commissioner is hereby authorized to charge any fees required by this action or any future action to Deposit Account No. 16-1435.

Should the Examiner have any questions relating to the instant application, the Examiner is invited to telephone the undersigned at (336) 607-7486 to discuss any issues.

Respectfully submitted,

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